Brief in Support of Accompanying Petition for Certiorari

THE OPINION BELOW

The opinion rendered by the United States District Court for the District of New Jersey is reported at 40 F.S. 393 and appears in the Transcript filed concurrently herewith.

The opinion of the United States Circuit Court of Appeals for the Third Circuit (by Jones, C. J.) is reported at ..... Fed. (2d) ....., and likewise appears in the accompanying Transcript.

THE JURISDICTION

The judgment, a review of which is sought, was rendered November 20, 1942. The authority of this Court is invoked under the provisions of the United States Code, Title 28, Section 347 (a) and of Rule 38 of this Court.

STATEMENT OF THE CASE AND SPECIFICATION OF ERRORS

The petitioner, by virtue of assignment, is the owner of Jones Reissue patent 19,562 for Mask for Fowls, reissued on May 7, 1935. Petitioner is also the patentee and owner of Cridlebaugh Patent 2,079,107, for Device for Preventing Picking in Poultry, granted May 7, 1937. To the commercial embodiments of the subject matter of these two patents petitioner applies the common law trade mark "Specs". (Note: Petitioner registered the trade mark

"Hen Specs" in the United States Patent Office, No. 379,108, dated July 2, 1940, pursuant to the provisions of the Act of February 20, 1905, as amended (U. S. C. title 15, Sec. 81, et sequentia) but no complaint is predicated thereon, the registration having been obtained after this suit was filed (October 26, 1938).)

The suit charges respondent with infringement of the reissue and original patents in suit; with infringement of the common law trade mark "Specs" in the use of the synonym "Goggles", and with unfair competition arising out of respondent's use of the infringing mark "Goggles" and certain methods of advertising. Respondent filed a counterclaim but with that we are not concerned for the purposes of this petition.

The United States District Court for the District of New Jersey held both the reissue and original patents valid and infringed; held the trade mark "Specs" valid and infringed by respondent's use of the synonym "Goggles", and held that the respondent had been guilty of unfair competition in his use of the word "Goggles" and his methods of advertising. The Circuit Court of Appeals reversed as to all grounds.

The errors relied upon as ground for review and reversal of the decision of the court below, are as follows:

1. The Court below erred in holding that even in the absence of a challenge of validity by either of the parties to a suit for patent infringement, a court may nevertheless pass on that question, and in holding the reissue and original patents in suit anticipated by prior art patents discarded by the respondent at the trial.

2. The court below erred in holding, in effect, that an applicant is barred from claiming operational, as distinguished from structural, characteristics shown in his drawing but not specifically described in his specification.

3. The court below erred in holding that the introduction into a reissue claim of operational, as distinguished from structural, characteristics shown in the patentee's drawing but not specifically described in his original specification is not permitted by the statute and in holding the Jones Reissue patent No. 19,562, for that reason, invalid.

4. The court below erred in holding that communication by an assignee of an interest insufficient to enable him to control prosecution of an application for letters patent, to the inventor of said assignee's belief of inadequacy of protection afforded by claims, prior to the issuance of an original patent, will bar subsequent, timely reissuance of the patent.

5. The court below erred in holding that the word "Specs", as applied to Masks for Fowls, i. e. mechanical devices fitted on a chicken's beak and designed to partially obstruct forward vision on a horizontal plane as a means of preventing picking, is but a "figurative description" of the plaintiff's article of manufacture and does not grow out of either the origin or ownership of the goods and that petitioner is not entitled to the exclusive use of the word or its synonyms.

6. The court below erred in holding that in a suit for infringement of a common law trade mark a court may adjudicate the validity of the mark despite a concurrent holding that the plaintiff (petitioner here) had failed to establish a case of trade mark infringement.

7. The court below erred in holding that in a suit for infringement of a common law trade mark the plaintiff must show that actual confusion has occurred as distinguished from a showing that a likelihood of confusion exists (i. e., the use of a word mark and its synonym).

ARGUMENT

A. The Questions as to Validity of the Patents

1. In passing on the validity of the Jones Reissue patent No. 19,562 and Cridlebaugh patent No. 2,079,107, the Circuit Court of Appeals said:

> "While the defendant at trial made reference to the art as it existed prior to Jones, he studiously refrained from citing it as anticipation. The reason for his so doing is not hard to perceive. The defendant's patent (No. 2,181,070) granted November 21, 1939, and under which he manufactured and sold his accused device, is so similar in principle to the Jones and Cridlebaugh devices that he undoubtedly hesitated to assail the Jones and Cridlebaugh patents on the ground of anticipation lest he, at the same time, inpugn his own patent. But the fact that the defending party to an infringement suit seeks to obviate the question of patentability of the disclosure involved does not exclude that issue. It inheres none the less in the charge of infringement. In such instance the parties are powerless to foreclose the court from determining whether the patent does in fact cover invention. The duty to protect the public from the imposition of an unwarranted monopoly requires no less. See Densmore v. Schofield, 102 U. S. 375,378.

From the foregoing it will be seen that the Circuit Court of Appeals has, on its own motion, applied certain prior art patents to *anticipate* the reissue and original letters patent in suit, although the respondent did not deem them sufficient to justify a contention that the claims of either of the patents were anticipated and categorically withdrew, by his statement during the trial, any and all defenses with respect to anticipation pleaded in his answer.

Concededly, the prior art patents were available to the Circuit Court of Appeals *as evidence showing the state of the art* to aid in the proper construction of the patents in suit, but petitioner respectfully submits that the principles underlying the requirement of the statute (R. S. 4920, U. S. C. Title 35, sec. 69) that notice be given of any defense by way of prior patents, publications, or public use relied on to show want of novelty or invention, are as applicable to the courts, acting on their own motion, as they are to the parties to a suit.

Grier v. Wilt, 7 S. Ct. 718, 120 U. S. 412, 30 L. Ed. 712;

Eachus v. Broomall, 6 S. Ct. 229, 115 U. S. 429, 29 L. Ed. 419.

The reason for the requirement of the notice (R. S. 4920, U. S. C. Title 35, Sec. 69) is to guard the patentee from being surprised on the trial by evidence of a nature which he could not be presumed to know or to be prepared to meet *(Teese v. Huntingdon,* 23 How. 2, 16 L. Ed. 479; *Blanchard v. Putnam,* 8 Wall. 420, 19 L. Ed. 433) and the patentee is none the less surprised that a District Court, or a Circuit Court of Appeals on appeal, on the court's

own motion, injects the question of anticipation than if the defendant failed to give the requisite notice.

Referring particularly to the Cridlebaugh patent 2,079,-107, it should be noted that, on appeal to the Third Circuit Court of Appeals, the respondent did not challenge validity on *any grounds*, for which reason it was error for the Circuit Court of Appeals, on its own motion, to pass on that question. See:

> *Exhibit Supply Co. v. Ace Patents Corporation*, 315 U. S. 126.

2. The second question presented by the accompanying petition relates to the disclosure requisite in a patent application to support the claims asserted.

Petitioner contends that when an operational, as distinguished from a structural, characteristic of a device is shown in the drawing accompanying and forming a part of a patent application, the applicant may claim such operational characteristic even though it is not specifically described in his specification.

The governing statute (R. S. 4888, U. S. C., title 35, sec. 33) calls for a disclosure sufficiently clear to

> "* * * enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same * * *."

Where any "good mechanic" acquainted with the subject matter, and having the drawing before him, would have no difficulty in adopting the improvement, it can-

not be said the disclosure is inadequate *(Ives, et al. v. Hamilton,* 92 U. S. 426).

The test to be applied is whether the device embodies the generic principle and works *(Hildreth v. Mostoras,* 257 U. S. 27, 34; *Telephone Cases,* 126 U. S. 1, 535). Thus mere failure to specifically describe or illustrate in the drawings the final, operative form of the invention will not invalidate a claim when the disclosure contemplates adjustment or change in a degree sufficient to accomplish the objects of the invention *(Johnston v. Woodbury,* 109 F. R. 567 (C. C. A. 9th)).

Defining a pin as a "pivot" or as permitting a "swinging movement" of the device retained thereby, when these operational characteristics are inherent in the device illustrated, does not violate the rule against new matter. *Safeway Steel Scaffolds Co. v. Patent Scaffolding Co.,* 110 F. (2d) 1008 (C. C. A. 7); *Wezel & Naumann Aktiengesellschaft v. Morgan Lithograph Co.,* 54 F. (2d) 235 (C. C. A. 2).

3. The third question relates to the reissue practice. It is petitioner's contention that here the reissue claims merely introduced an operational characteristic shown in the original drawings though not specifically described in the specification. As such the case will at once be seen as presenting an entirely different problem from one in which there was no disclosure at all of the matter of the reissue (cf. *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.* 315 U. S. 668, 676).

Here petitioner is relying upon the drawings of the original Jones patent 1,962,395 as evidence of the fact

that the reissued patent (19,562) is for the same invention as the original patent and as the foundation for the right to introduce in the reissue application claims drawn to the operational characteristics of that device depicted in the drawings. It is submitted that this is proper reissue practice.

Woolwine Metal Products Co. v. Boyle, 279 F. R. 609, 611 (C. C. A. 9th);

Perfection Disappearing Bed Co., Inc. v. Murphy Wall Bed Co., 266 F. R. 698 (C. C. A. 9th).

The claims introduced in the reissue in the present case attribute a pivotal operation to a pin member and the drawing in the original application plainly shows the pin to have such characteristic. The mere fact that another and different element had theretofore been defined as having a different pivotal operation does not alter the situation.

The fact that the operational characteristic is inherent in the thing exhibited in the drawing is believed to be the controlling factor and the right to cover such characteristic in reissue claims is believed clear.

Topliff v. Topliff, 145 U. S. 156, 170; 12 Sup. Ct. 825, 831;

Prescott v. Swain, 22 F. (2d) 1004.

Clearly the introduction of the characteristic in the reissue claims cannot be said to violate the rule against the insertion of "new matter". *Wezel & Naumann Aktiengesellschaft v. Morgan Lithograph Co.,* supra, and *Safeway Steel Scaffolds Co. v. Patent Scaffolding Co., et al.,* supra.

4. Petitioner herein was the assignee of a 49% interest in the subject matter of the original Jones patent No. 1,962,395 during the pendency of the application. Prior to issuance of that patent he acquired the belief that the claims then asserted by Jones did not adequately protect the invention and communicated that belief to Jones. The original Jones patent then issued (June 12, 1934) on the basis of the claims questioned by petitioner. One month later (July 12, 1934) Jones applied for reissuance of the patent introducing the claims in suit of the scope suggested by petitioner and the grant of the reissue patent followed (Reissue patent No. 19,562, May 7, 1935). It will be noted that the reissue application was filed within *one month* of issuance of the original patent, precluding any contention as to untimeliness.

The Circuit Court of Appeals took the position that it was:

> "indeed difficult to se how Jones was in a position to make the requisite oath to a reissue application, viz., that the matter omitted from the original application was omitted therefrom through 'inadvertence, accident or mistake', etc."

It is axiomatic that petitioner, as assignee of a 49% interest could not control the prosecution of the application to the exclusion of Jones, under the Patent Office Rules of Practice promulgated by the Commissioner of Patents pursuant to Revised Statutes, Secs. 481, 483, 489 and Executive Order of March 17, 1925, 332 Off. Gazette 957.

Rule 5 thereof reads as follows:

> "The assignee of *the entire interest of an invention* is entitled to hold correspondence with the office to the exclusion of the inventor."

Rule 20 reads, in part, as follows:

> "* * * an assignment will not operate as a revocation of the authorization previously given, *but the assignee of the entire interest* may be represented by an attorney or agent of his own selection."

Since petitioner himself, as the assignee of a part interest in the invention, could not have asserted claims of the order he believed proper in the case, it is impossible to perceive how mere communication of his belief as to inadequacy of the claims, without evidence as to Jones agreement or disagreement in such belief, would bar the applicant (Jones) from asserting such claims as promptly as he did by reissue application filed *one month* after the date of issuance of the original patent.

This seems particularly so in view of the fact that the Patent Office tribunals have consistently held that the applicant's statements in the reissue oath that he has obtained insufficient claims in his patent to cover the invention is a valid ground for reissue (*Ex Parte Smith*, 44 U. S. P. Q. 546; *Ex Parte Walker*, 40 U. S. P. Q. 578; *In Re Briede*, 27 App. D. C. 298) and a similar rule has been followed by the Courts (*Robert v. Krementz*, 243 F. R. 877, 881 (C. C. A. 3) and *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.*, 266 F. 698, 699 (C. C. A. 9) both citing *Topliff v. Topliff*, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. Ed. 658).

It is obvious that to say that the Jones Reissue patent No. 19,562 could not be reissued will operate with great hardship upon petitioner who has since acquired all right and title to the patent (*Topliff v. Topliff*, supra).

B. The Validity of the Word "Specs" as a Common Law Trade Mark and the Test of Infringement to be Applied Thereto.

1. This Honorable Court has heretofore taken occasion to lay down the test of a valid, technical common law trade mark. This Court has held that one of the rules to be followed is that a generic name, or a name *merely descriptive* of an article of trade, of its qualities, ingredients, or characteristics, cannot be employed as a trade mark and the exclusive use of it be entitled to legal protection (*Canal Co. v. Clark*, 80 U. S. 311, 323).

This Court has also recognized that the term "trade mark":

> "* * * has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular manufacturers may be distinguished from those of others. It may consist in any symbol or in any form of words, but as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trade-mark, which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose."
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> *Elgin National Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, 673.

In the face of these and similar pronouncements by this Court the Circuit Court of Appeals held that the word "Specs" as applied to petitioner's goods was but a "figurative description" and did not grow out of either the origin or ownership of the goods and that plaintiff was not entitled to the exclusive use of the word or its synonyms.

Petitioner has searched in vain for judicial interpretation of the expression "figurative description". If taken at its generally accepted and dictionary definition the word "figurative" must be understood as used in its metaphorical sense; then the term "figurative description" would mean that "Specs" is not a literal description of petitioner's articles. That being so "Specs" would not be "merely descriptive" (*Canal Co. v. Clark*, supra) but rather suggestive and requiring some independent thought to attribute to it the slightest significance as to petitioner's goods.

Considering the generally accepted colloquial meaning of the word "Specs" (i.e., short for spectacles) the word must be regarded as having an incongruous significance when applied to a Mask for Fowls, viz. a mechanical device attached to a chicken's beak and designed to partially *obstruct* the forward vision of the fowl on a horizontal plane to prevent picking. That suggestive marks of this character have long been regarded as valid, technical marks, see

Sierra Chemical Co. v. Berettini, 33 Fed. (2d) 397 (C. C. A. 7th);

Roberts v. Sheldon, 8 Bissell 398, Fed. Case No. 11916, 18 O. G. 1277; 1880 C. D. 676 (C. C. Ill.);

Selchow v. Baker, 93 N. Y. 53, Cox 690 (Ct. of App. N. Y. 1888);

Globe-Wernicke Co. v. Brown et al., 121 F. R. 185;

United Lace & Braid Mfg. Co. v. Barthels Mfg. Co., 221 F. 456, 460;

Automatic Recording Safe Co. v. Banker's Registering Safe Co., 224 F. R. 506;

W. F. Burns Co. v. Automatic Recording Safe Co., 241 F. R. 472, 487 (C. C. A. 7th);

Waltke & Co. v. Schafer & Co., 263 F. R. 650;

W. G. Reardon Laboratories, Inc. v. B & B Exterminators, Inc., et al., 71 F. (2d) 515 (C. C. A. 4th);

Stoughton v. Woodward et al., 39 F. R. 902;

Eiseman v. Schiffer, 157 F. R. 473.

2. The Circuit Court of Appeals adjudged the mark "Specs" invalid as a common law trade mark despite a concurrent holding that the plaintiff (petitioner here) had failed to establish a case of trade mark infringement.

Petitioner submits that having found that a case of infringement had not been made out the Circuit Court of Appeals should have dismissed the bill without more. The respondent having in its favor a decree of non-infringement of the petitioner's common law trade mark had all the relief to which it was entitled. Analogy can be drawn to the decision of this Court in *Electrical Fittings Corp. et al. v. The Thomas & Betts Co. et al.*, 307 U. S. 241, 59 Sup. Ct. 860.

3. The Circuit Court of Appeals held that in a suit for infringement of a technical, common law trade mark,

> "the burden is on the one complaining to show by a fair preponderance of the evidence that the ordinary run of purchasers, giving that attention which such persons usually give to the buying of articles of the character involved, would likely be deceived."

and ruled that the plaintiff (petitioner here) had, in producing evidence of only a limited number of cases of *actual confusion*, failed to make out a case by a fair preponderance of the evidence either as to confusion of the buying public or deception by the defendant. The effect of the decision is to require *actual evidence of confusion* sufficient to constitute a fair preponderance of the evidence, as distinguished from a *likelihood of confusion.*

In so ruling the Circuit Court of Appeals has cast upon petitioner a greater burden than properly attends such cases. It is submitted that the rule applicable in cases of technical trade mark infringement is that proof of actual deception of purchasers is unnecessary if the trade marks so resemble each other that it is likely or probable in the sale of the goods that one will be mistaken for the other.

Nims on Unfair Competition and Trade Marks, Second Edition, Sec. 335;

Bissell Chilled Plow Works v. T. M. Bissell Plow Co., 121 F. 357;

Tumble v. Woodstock Mfg. Co., 297 F. 524, 529;

The Best Foods, Inc. v. Hemphill Packing Co., 5 F. (2d) 355, 357;

Walter Baker & Co. v. Delapenha, 160 F. R. 746, 749.

In showing use by respondent of the synonym "Goggles" in the face of prior use of "Specs" for the identical goods petitioner has met the proper test (cf. *Coca Cola Co. v. The Koke Co. of America, et al.*, 254 U. S. 143).

Respectfully submitted,

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